

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Parnanen, et al.
Title: SYSTEM AND METHOD FOR
DYNAMICALLY ADDING
FEATURES TO SOFTWARE
APPLICATIONS
Appl. No.: 10/762,051
Filing Date: 1/21/2004
Examiner: NGUYEN, PHILLIP H
Art Unit: 2191
Confirmation Number: 4470

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

REMARKS

In the outstanding Final Office Action of June 24, 2007 maintained his rejection of claims 1-20 because these claims allegedly fail to meet the requirement(s) of 35 U.S.C. §101. The Examiner asserted that the specification of the application provides no explicit and deliberate definition of the components, e.g., consumer application, provider application, and application interworking framework, “that make up the device/system other than they are could [sic] be software components, which are directed to functional descriptive material, per se, and are therefore, non-statutory.” As described in Applicant’s response of May 14, 2007,

e.g., Pgs. 11-12 and Table 1 of the present application clearly describe exemplary applications that are contemplated, e.g., editing an image in “Image Viewer,” and offering command options for found items in text in a browser messaging application, where a provider application is, for example, a phonebook application on a mobile device. Other examples, such as a “Media Gallery,” “Softkey selector,” “Voice commands,” are also contemplated. Hence, Applicant submits that definitions and examples are provided, all of which indicate that the claimed subject matter is not software per se. Moreover, it appears that the Examiner was referencing MPEP 2111.01, which indicates that plain meaning refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art. Contrary to the Examiner’s assertions, however, Applicant submits that the term “application,” ordinarily suggests some end result output/implementation that is physically effectuated, especially in the case of a “consumer” application, clearly suggesting some presentation or interactive aspect with a consumer end-user. Also, independent claims 8 and 17 of the present application recite a device/system, and Applicant submits that for the reasons discussed herein, e.g., implementation in a device such as a phone, it is not reasonable to interpret such claims as not having a physical/tangible implementation. For example, an Image Viewer that has a purely software basis would have the incongruous effect of an image viewer that a user would not be able to view images with. Therefore, an Image Viewer would be understood by those of ordinary skill in this or most any art to refer to software, implemented on some processor or other hardware to effectuate the presentation of images to a user. As well, a Softkey selector would be understood to refer to some implementation of software resulting in a user having the ability to select and/or actuate a softkey (e.g., a hardware key on a mobile device, for example, that can be assigned differing functions).

Moreover, Applicant submits that the present application is replete with references to menu service interfaces, user interfaces (UI), menu items, phones, etc. upon which the various embodiments described in the present application can be implemented. (*See, e.g.,* Figs. 2 and 5, Para. [0004], [0030], [0038], [0040], [0044], [0046], and [0061]). Therefore, it should be abundantly clear that the methods described in claims 1-20 are not software per se, and therefore, contrary to the Examiner’s assertions, do meet the statutory requirement(s) of

35 U.S.C. §101. As to the Examiner's further asserted requirements, Applicant submits that the processes described in claims 1-20 of the present application are "acts" that are being performed. The language of claim 1, for example, indicates a process of requesting a matching feature, using a consumer interest to identify, providing a feature to a consumer application, and utilizing the feature, i.e., "acts." Applicant is at a loss to how any other characterization can be given to a method, other than acts that are performed.

Applicant also discussed at length why claims 1-20, even if they could be characterized as software per se, are not automatically deemed to be non-statutory subject matter because they recite methods that produce concrete, tangible, useful results in accordance with *State Street Bank & Trust v. Signature Financial Group, Inc.* 149 F.3d 1368, 47 USPQ2d 1569 (Fed. Cir. 1998).¹ Applicant incorporates those arguments by reference in their entirety and maintains that the production of concrete, tangible, useful results, e.g., utilizing the feature at the consumer application and publishing a feature interest, as recited in claims 1, 8, and 17 describe statutory subject matter. In addition, the Examiner asserted that a claim reciting a computer program embodied/encoded on a computer readable medium would define a structural interrelationship between a computer program and the rest of the computer. Applicant submits that such language is required when, for example, a computer program product is claimed, e.g., claim 21 of the present application, but submits that such reasoning is being improperly applied and forcing improper limitations on claims 1-20.

With regard to the Examiner's response to Applicant's arguments of May 14, 2007, Applicant submits that the Examiner is still mischaracterizing the prior art, particularly with respect to the downloading of complete applications. For example, at Pg. 3 of the outstanding Office Action, the Examiner asserted that Mehta et al. discloses "dynamically download new and updated applications from the MAS for use on their devices. Updating an application is to add new features or replace existed [sic] features to an application. Therefore, updating an application is in fact, the same as adding feature to an application." Applicant previously argued that Mehta teaches handling complete applications and

¹ It should be noted that in the previous Office Action of March 12, 2007, the Examiner asserted that claims 1-20 of the present application did not satisfy the requirement(s) of 35 U.S.C. §101 because they did not produce a concrete, tangible, useful result, in addition to those reasons described above, but has removed any reference to that reasoning and has not rebutted Applicant's arguments in response thereto.

downloadable media content for use with applications on a mobile device, e.g., a ring tone or graphical icon. In no way does Mehta et al. ever contemplate, let alone disclose the ability to add features to an application. At best, the new applications and/or content of Mehta et al. could be interpreted, for the sake of argument, to be analogous to the consumer application. However, as described above, it is a feature that is utilized with/at the consumer application, where the feature is added in accordance with a consumer interest and provided by a provider. In other words, as admitted by the Examiner, Mehta et al. merely teaches downloading applications where, regardless of whether the applications are “updated,” the applications are still downloaded in a complete form. In contrast, independent claims 1, 8, 17, and 21 disclose processes for adding a feature to a consumer application, for example, that is already operational – hence “dynamically adding” features by requesting an API framework matching a consumer interest, using the consumer interest and feature capability to identify a provider, providing the feature, and utilizing the feature at the consumer application. This is very different from merely downloading a complete application once the application has been updated.

As to the combination of Mehta et al. and Rothman et al., the Examiner asserted on Pg. 4 of the outstanding Office Action that “[i]n fact Mehta discloses an interface for a consumer application and provider application such that a feature interest is matched with one of the features available from the provider application.” Yet, in the previously filed Office Action of March 12, 2007 at Pg. 10 and as maintained in the outstanding Office Action at Pgs. 9-10, the Examiner wholly contradicts himself by stating that “Mehta does not explicitly disclose: an application interworking framework that provides an interface for the said consumer application and the said provider application such that the said features interest is matched with one of the features available from the said provider application.” Notwithstanding this entirely irreconcilable contradiction, Applicant submits that the Examiner completely ignored Applicant’s detailed arguments outlining the various differences between “firmware” and “applications,” and “software” and “hardware,” at Pgs. 6-7 of Applicant’s previous response. Thus, the Examiner failed to further support his position or rebut Applicant’s arguments indicating that it would not have been obvious to combine Mehta et al. and Rothman et al. because one is directed to applications, while the other is directed to firmware or, even if they could be combined, that the resulting system

would merely provide a way to update complete applications and a way to update firmware using an OS-agnostic API framework. Instead, the Examiner merely stated that “[a]gain, updating firmware to an operating system is the same as adding new feature or replacing existed features to an operating system. Therefore, updating an operating system software is the same as adding feature to an application.” In fact, the Examiner merely bolstered Applicant’s arguments by admitting that “MAS (described in Mehta et al.) is a framework that implements an application program interface,” while Rothman et al. teaches ““a system/method of updating firmware in an operating system.”” Hence, Applicant submits that the Examiner has failed to support, with adequate reasoning, his rejection of claims 1-3 and 5-23 of the present application.

Lastly, at Pg. 5 of the outstanding Office Action, the Examiner cited MPEP 2111[R-1] indicating that the Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification and that pending claims must be given their broadest reasonable interpretation consistent with the specification. While Applicant can appreciate such guidelines, Applicant submits that they are misplaced in this case. The Examiner is inappropriately presenting an overly broad interpretation/teaching of the prior art. That is, the Examiner is reading limitations and/or interpreting the prior art in a manner inconsistent with what is being explicitly described in the prior art and how one of ordinary skill in the art would interpret terms, functions, and operations described in the prior art. Therefore, Applicant submits that the cited prior art cannot be used as grounds for rejecting the claims of the present application.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

Date: October 24, 2007

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 037145-0901	
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	First Named Inventor Matti Parnanen		
	Art Unit 2191	Examiner NGUYEN, PHILLIP H	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>37,268</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> </div> <div style="width: 45%; text-align: center;"> <p><u>/G. Peter Albert Jr./</u> Signature</p> <p><u>G. Peter Albert Jr.</u> Typed or Printed Name</p> <p><u>(858) 847-6735</u> Telephone Number</p> <p><u>October 24, 2007</u> Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of 1 forms are submitted.</p>			

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